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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/900,787	07/06/2001	Matthew Levine	MLE-10502/29	7680

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EXAMINER

LIANG, LEONARD S

ART UNIT	PAPER NUMBER
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2853

DATE MAILED: 10/22/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/900,787

Applicant(s)

LEVINE, MATTHEW

Examiner

Leonard S Liang

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-14 and 16 is/are rejected.
- 7) ☒ Claim(s) 9 and 15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07/06/01 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 114. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### *Specification*

2. The disclosure is objected to because of the following informalities: On page 2, lines 8-9, the specification states "The need remains, therefore, for a chart recorder which is more easily **programming...**" This is a minor grammar error. It will be construed that the specification should read "The need remains, therefore, for a chart recorder which is more easily **programmable...**" Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-8 and 11-14 rejected under 35 U.S.C. 102(b) as being anticipated by Levine (US Pat 5978000).

Levine discloses, with respect to claim 1, a method of programming an instrument of the type wherein a marking implement is used to mark a surface (See figure 1, reference 102, 108; abstract).

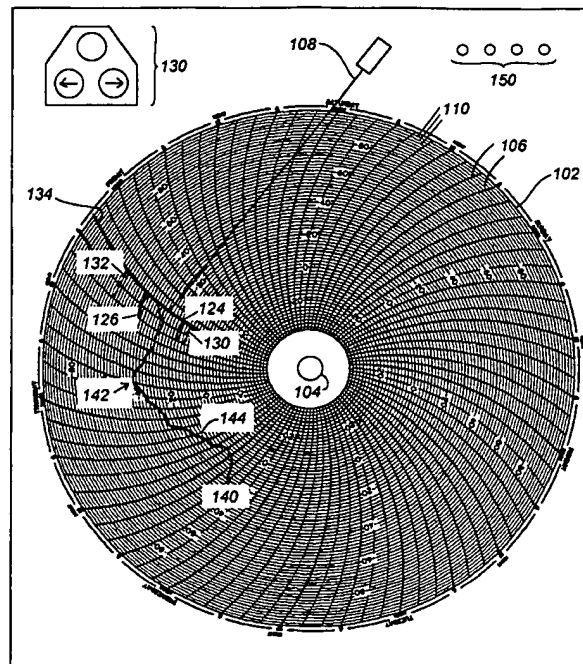
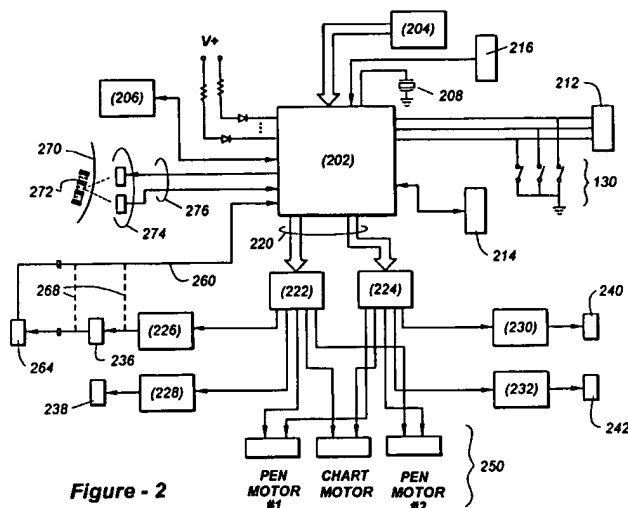


Figure - 1

the method comprising the steps of:

- providing a surface (See figure 1, reference 102) including visible options (See figure 1, references 106, 110) relating to the programming of the instrument
- storing information relating to the location of surface positions accessible by the marking implement (See figure 2, references 202, 204, 216; column 3, lines 41-65)



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 5,978,000

- moving at least the marking implement (See figure 1, reference 108) relative to the visible options for selection purposes (See figure 1, references 106, 110; column 2, lines 60-67)
- programming the instrument by correlating the position of the implement/pen during the movement thereof to determine the options selected (See column 1, lines 55-67)

Levine discloses, with respect to claim 11, a method of programming a chart recorder having a pen to mark a chart (See figure 1, reference 102, 108; abstract) comprising the steps of:

- providing a chart (See figure 1, reference 102) including printed parameters (See figure 1, references 106, 110) relating to the programming of the instrument
- placing the chart in a start position (See column 3, lines 6-11), enabling the recorder to advance to known positions on the chart using movements of the pen, chart, or both (See figure 2, reference 61-67)
- moving at least the pen (See figure 1, reference 108) relative to the printed parameters so as to select certain of the parameters by marking the chart with the pen (See figure 1, references 106, 110; column 2, lines 60-67)
- programming the recorder by correlating the position of the pen (See figure 1, reference 108) relative to the chart (See figure 1, reference 102; column 1, lines 55-67)

Levine discloses, with respect to claims 2 and 12, that the step of moving at least the implement includes moving the implement in two dimensions (See figure 1, references 124, 126; column 2, lines 60-67).

Levine discloses, with respect to claim 3, the moving of the surface relative to the implement during the selection process (See figure 1, reference 102; column 3, lines 6-11).

Levine discloses, with respect to claim 4, that the instrument is a chart recorder and the surface is on a chart (See figure 1, reference 102; column 1, lines 13-15).

Levine discloses, with respect to claims 5 and 13, that the chart is a circular chart (See figure 1, reference 102; column 1, lines 58-61).

Levine discloses, with respect to claims 6 and 14, that the visible options/printed parameters relate to the operation of an external controller (See column 1, lines 64-67)

Levine discloses, with respect to claim 7, the step of indexing the surface relative to a start position in conjunction with the step of storing information relating to the location of surface positions accessible by the marking implement (See column 3, lines 6-11).

Levine discloses, with respect to claim 8, that the options are selected by marking the surface with the implement (See figure 1, reference 108; column 3, lines 1-2).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 10 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levine in view of Ishiguro (US Pat 4836742), and further in view of Watanabe (US Pat 4025838).

Levine discloses, with respect to claims 10 and 16, a method of programming an instrument, as discussed in claim 1 above, as well as a method of programming a chart recorder, as discussed in claim 11 above.

Levine differs from the claimed invention in that it does not disclose the marking of a new surface/chart in response to a user command subsequent to the programming of the instrument to obtain a record of currently selected options.

Ishiguro discloses, with respect to claims 10 and 16, the marking of a surface (See figure 1, reference 18; column 3, lines 12-16). Ishiguro also discloses the “teaching” of robots (See column 1, lines 30-34), so that they can learn a set of user commanded options, and then play back these currently selected options to obtain a record on a new surface.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teachings of Ishiguro into the invention of Levine, so that there would be a step of marking a new surface in response to a user command subsequent to the programming of the instrument to obtain a record of currently selected options. The motivation for the skilled artisan in doing so is to gain the benefit of being able to reproduce a record of currently selected options without manually repeating the instrument programming operation continuously (See Watanabe column 1, lines 6-15).

#### ***Allowable Subject Matter***

5. Claims 9 and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 9 and 15 include the limitation “method...wherein the options are selected by underscoring, circling, or otherwise highlighting desired options/parameters, or by striking out undesired options/parameters,” which was not found, taught, or suggested in the prior arts.

#### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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McKinley (US Pat 5019838) discloses a rotational planar chart recorder and chart therefore.

***Response to Arguments***

7. Applicant's arguments filed on 09/14/02 have been fully considered but they are not persuasive.

In claim 1, with respect to the limitation "providing a surface including visible options *relating to the programming of the instrument*," the applicant argues that the examiner's rejection is in error. According to the applicant "With respect to this limitation, the Examiner refers to Figure 1, reference numerals 102, 106, and 110, which are simply the chart itself with intersecting lines printed thereon. These have nothing to do with the programming of the instrument, but rather, something that the instrument, once programmed, overwrites.

Anticipation is precluded for this reason alone." The examiner acknowledges the applicant's response, but must respectfully disagree. Levine (US Pat 5978000) teaches that "These lines 106 **are usually indicative of time**, with the paper rotating uniformly in a particular direction, whereas the concentrically circular lines 110 representative of a second dimension, **are usually indicative of a measured quantity, such as pressure, temperature, humidity, etc.**" (column 2, lines 47-53) The applicant himself teaches that the visible options relate to one or more of the following: date or **time**... (claim 6). Therefore, the lines on the chart are not simply arbitrary lines, but rather, they represent visible options relating to the programming of the instrument.

In claim 1, with respect to the limitation "storing information relating to the location of surface positions accessible by the marking implement," the applicant argues that "the examiner points to figure 2, and the specification at column 3, lines 41-65 discusses the hardware.



Pointing to particular structural elements, even if they could perform a particular function, falls short of anticipating a method step...In this case, a “microprocessor” or other electronic circuit does not “disclose” any method.” In response to this argument, the examiner would like to draw the applicant’s attention to Levine column 3, lines 44-51, where it states “In the embodiment shown, a ROM 204 is used to store a software program according to the invention to bring about, in conjunction with hardware described below, the various functions described herein.

Preferably, set point data is contained in a non-volatile memory of some form, such as electrically erasable programmable read-only memory...” While it is true that hardware is discussed (i.e. microprocessor, ROM), it is equally true that a method of storing information is also discussed (in this case, “set point data is contained in a non-volatile memory”; that is a method step). Furthermore, the hardware discussed (i.e. microprocessor, ROM) inherently implies a method of storing information.

In claim 1, with respect to the limitation “moving at least a marking implement relative to the visual options for selection purposes,” the applicant argues that “a marking implement is not moved relative to visible options for selection purposes, since the visual options are not yet there.” However, if we take the chart lines to represent visible options, as taught above, it is apparent that the pen 108 (i.e. marking implement) does move relative to the visual options for selection purposes.

In claim 1, with respect to the limitation “programming the instrument by correlating the position of the implement during the movement thereof to determine the options selected,” the applicant argues that “the examiner points to column 1, lines 55-67 which discusses only the fact that set points may be programmed into a chart recorder and made visible on the chart recorder

paper. Again, this has nothing to do with selecting existing options, but rather, involves a technique whereby predetermined set points are made visible.” Again, if we take the chart lines to represent visible options, as taught above, it is apparent that programming the set points into the chart recorder is the equivalent of correlating the position of the implement during the movement thereof to determine the options selected; different locations on the chart lines (i.e. visible options) represent different parameters (i.e. options).

In claim 11, with respect to the limitation “moving at least the pen relative to the printed parameters so as to select certain of the parameters by marking the chart with the pen,” the applicant argues, “There are no ‘printed parameters’ disclosed...which would be applicable to this claim.” Again, if we take the chart lines to represent visible options, as taught above, it is apparent that the chart lines serve as applicable printed parameters.

For claims 10 and 16, the applicant argues that “the Levine/Ishiguro/Wtanabe combination does not render claims 10 and 16 obvious. First, there is no teaching or suggestion from the prior art as to the combination of elements in relation to claims 10 and 16, and even if there were such a teaching or suggestion, the invention of claims 10 and 16, in combination, would not be the result. Furthermore, given that the invention of Ishiguro and Watanabe are directed to entirely different subject matter, these represent non-analogous reference, and do not apply to this case.” In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest

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all the claim limitations. With respect to claims 10 and 16, it is shown above that Levine fails to disclose one limitation, that is, the marking of a new surface/chart in response to a user command subsequent to the programming of the instrument to obtain a record of currently selected options. As taught above, Ishiguro suggests this limitation, and Watanabe gives motivation for it. When Levine is taken in combination with Ishiguro and Watanabe, there is reasonable expectation of success, in that the combination would account for the missing limitation of Levine, thus the inventions of claims 10 and 16 would result from the combination. Finally, it is apparent that the references when combined suggest all the claim limitations. As for the argument that Ishiguro and Watanabe are directed to entirely different subject matter as the applicant's invention, it is noted that Ishiguro and Watanabe teach the marking of a new surface/chart in response to a user command subsequent to the programming of the instrument to obtain a record of currently selected options, thus they perform the same function as the applicant's invention, and can thus be considered analogous references.

### ***Final Rejection***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

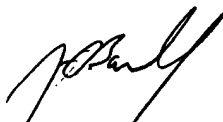
will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leonard S Liang whose telephone number is (703) 305-4754. The examiner can normally be reached on 8:30-5 Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Barlow can be reached on (703) 308-3126. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7724 for regular communications and (703) 308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

lsl LSL  
October 9, 2002

  
John Barlow  
Supervisory Patent Examiner  
Technology Center 2800